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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/553,183   | 07/21/2006  | Matthias Fies        | C 2684 PCT/US       | 2216             |
| 23657  | 7590        | 11/29/2009           |                     |                  |
| FOX ROTHSCHILD LLP<br>2000 MARKET STREET<br>PHILADELPHIA, PA 19103 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| CAMERON, ERMA C  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1792   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
| 11/20/2009   |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

# Office Action Summary

**Application No.**

10/553,183

**Applicant(s)**

FIES ET AL.

**Examiner**

/Erma Cameron/

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 11-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SI/200)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-13, 15, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10 - 218946.

See Abstracts and partial machine translation.

'946 teaches a dimerdiol di(meth)acrylate in a heat or radiation curable coating (see Abstracts; claims; [0004]-[0006]). The coating may be applied to steel (see Abstracts). The degree of esterification appears to at least overlap with that claimed by applicant. The flattening properties are inherent to the coating composition.

#### ***Response to Arguments***

The applicant has argued that '946 teaches that unalkoxylated dimerdiol constitutes only 5% of the coating composition. The examiner disagrees. [0010] discloses that compound B, the dimerdiol di(meth)acrylate, can be as much as 90% of the coating. The property of exhibiting flattening properties is inherent to the dimerdiol di(meth)acrylate.

3. Claims 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/58030.

'030 teaches DPGDA (dipropylene glycol diacrylate, one of the compounds used by applicant; also known as Photomer 4226; see CAS Registry file printout of RN 57472-68-1) at 10-40 wt%, as well as silica, to obtain photocurable matt coatings (see Abstract; pp 2, 4, 5, 6 and claims). The substrate is not disclosed, thus making any substrate possible.

***Response to Arguments***

The applicant has argued that '030 does not teach a dimerdol (meth)acrylate. The examiner disagrees. '030 teaches the use of dipropylene glycol diacrylate (see Abstract), one of the compounds used by applicant as a flatting agent. The applicant has also argued that there is no evidence that this compound is effective as a flatting agent in the absence of an additional solid flatting agent such as silica. The examiner's response is that because both '030 and the applicant use the same flatting agent, dipropylene glycol diacrylate, the efficacy of this compound as a flatting agent, with or without silica present, is inherent to the compound.

4. Claims 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thames et al (6001913).

'913 teaches a UV curable coating composition that comprises 17 wt % Photomer 3016, one of the compounds used by applicant, and therefore inherently meeting the esterification and flatting limitations, as well as silica (see Abstract; 10:53-61; 12:31-65; Example 8). The

substrates are wood, metal, plastic and paper (example 8). The examiner considers these substrates to be merely exemplary, and not to preclude other substrates such as glass.

Silica is known as a solid flattening agent.

***Response to Arguments***

The applicant has argued that '913 does not disclose a dimerdiol (meth)acrylate component. The examiner disagrees. Photomer 3016 (Example 8) is bisphenol A diglycidyl ether diacrylate, whose structure is that of a dimerdiol with acrylate groups on the hydroxy groups. The applicant has also argued that the reference does not teach flattening activity. It is the examiner's position that the flattening activity is inherent in the dimerdiol (meth)acrylate, Photomer 3016.

5. Claims 11-13, 15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gloster et al (US2004/0006157).

'157 teaches a UV curable ink that contains 20% Photomer 4226, one of the compounds used by applicant (dipropylene glycol diacrylate), and therefore inherently meeting the esterification and flattening limitations (see Abstract; Table on page 4, Examples 1 and 2). The substrate that the ink is applied to is not specified, thus any substrate may be used in this process.

***Response to Arguments***

The applicant has argued that '157 does not teach as dimerdiol (meth)acrylate. The examiner disagrees. The dipropylene glycol diacrylate taught by '157 (Table on page 4) is a dimerdiol of acrylate. The applicant has also argued that the reference does not disclose any

flattening activity. It is the examiner's position that the flattening activity is inherent in the dipropylene glycol diacrylate.

6. The rejection of Claims 6-7, 11 and 13-14 under 35 U.S.C. 103(a) as being unpatentable over Narayan et al (6239189) is withdrawn because of the amendment of 7/9/2009.

It appears that '189 does not have enough of Photomer 3016 (3:57-64) to have a flattening effect.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 11-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-26 of copending Application No. 10/553483. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is a (meth)acrylate- and dimerdioi-based flattening composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The examiner acknowledges that the applicant has requested that this rejection be held in abeyance. This will be done.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/  
Primary Examiner  
Art Unit 1792

November 17, 2009